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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/003,592 | 11/01/2001 | Ralph M. Sias | 11740 | 4756 |

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EXAMINER

JASTRZAB, KRISANNE MARIE

ART UNIT PAPER NUMBER

1744

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,592

Applicant(s)

SIAS ET AL.

Examiner

Krisanne Jastrzab

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/28/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7 and 11-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sangster et al., U.S. patent No. 5,750,072.

Sangster et al., teach a method and apparatus for sterilizing with an activated vapor sterilant. The apparatus includes a source of sterilant, preferably hydrogen peroxide, means to form a mist of the sterilant, and means for activating the mist. The apparatus can be included in an enclosure for treating a work piece, or it can generate an activated mist for an unenclosed area surrounding a surgical site. See column 2, lines 19-35, column 4, lines 32-42 and 53-56 and column 5, lines 10-13 and 38-40.

Claims 1, 7, 9, 11, 13, 15-17 and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Weibel U.S. patent No. 5,648,046.

Weibel teaches a method and apparatus for disinfecting air in air conditioning ducts. The apparatus forms a mist of a disinfectant and activates it with an ionizing electrode means and sends it to the air to be treated. See column 2, lines 5-65.

Claims 1, 6, 9-11, 13 and 15-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Peltier U.S. patent No. 5,382,410.

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Peltier teaches an activated aerosol generator and a method of using it to treat a given atmosphere. The aerosol can be generated from a disinfectant, fungicide, bactericide or viruscide. The activation of the aerosol is achieved by a tunable, DC power supply and the generation occurs at atmospheric pressure. See column 2, lines 47-68, column 3, lines 10-12 and 25-30 and 54-59, column 4, lines 52-55, column 8, lines 11-15, column 9, lines 17-21 and column 10, lines 11-17 and 45-52.

Claims 1, 7, 9-11, 14-15 and 18-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Barditch U.S. patent No. 4,704,942.

Barditch teaches a method and apparatus for combating chemical and biological warfare agents in the atmosphere. The apparatus includes a source of disinfectant and means to generate a mist therefrom, and means to activate the disinfectant mist with a tunable transformer means. The activated mist is generated into the atmosphere containing the warfare contaminant and acts to neutralize that contaminant. See column 2, lines 5-30 and Fig.1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the references applied above.

It would have been well within the purview of one of ordinary skill in the art to include any known non-toxic additives in the disinfecting agents of the references above, such as chelating agents, because it is well recognized that such additives/agents function to optimize the distribution and contact potential of disinfecting agents.

Double Patenting

Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/140851. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are the same method and apparatus differing only in that '851 specifies the use of the activated mist in neutralizing chemical and biological warfare agents, which use is not excluded by the breadth of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

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Applicant's arguments filed 12/28/2004 have been fully considered but they are not persuasive.

Applicant argues that Sangster fails to teach activation of the mist with electronic or photonic energy means as required by newly amended claim 1, however, the Examiner would disagree and point out that Sangster clearly teaches the recognized conventionality of activation of gases with electronic and photonic means while proposing magnetic means as an alternative energy source applicable to human skin. See column 1, lines 15-35 and column 2, lines 10-16.

Applicant further argues that Weibel, Peltier and Barditsch all fail to teach "activation" of the mist because Applicant alleges that they do not teach the formation of free radicals, however, the Examiner would point out that all three references clearly, minimally, teach electrostatically charging the mist particles to enhance their sterilant and contact efficacy, and that such charging is clearly "activation".

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

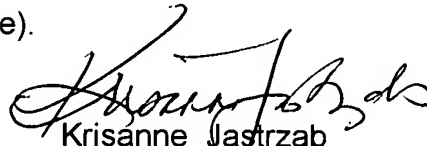
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisanne Jastrzab whose telephone number is 571-272-1279. The examiner can normally be reached on Mon.-Wed. 6:30am-4:00pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Kim can be reached on 571-272-1142. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Krisanne Jastrzab
Primary Examiner
Art Unit 1744

March 9, 2005